

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Request for Examiner Interview

Applicant respectfully requests an Examiner Interview to discuss the referenced application at a date and time convenient for all parties. An Applicant Initiated Interview Request Form is attached to this response.

Disposition of Claims

Claims 1-5 were pending in the present application. By way of this reply, claim 6 has been added, and claim 3 has been cancelled without prejudice or disclaimer. Accordingly, claims 1-2 and 4-6 are now pending in this application. Claims 1 and 5 are independent. The remaining claims depend, directly or indirectly, from claim 1.

Claim Amendments

Claim 2 has been amended by this reply to correct a minor typographical error. Further, new claim 6 has been added and claim 3 has been cancelled by this reply without prejudice or disclaimer. New claim 6 corresponds to originally filed claim 3 of the referenced application, excluding reference characters. Finally, claim 4 has been amended to now depend from new claim 6. No new matter has been added by any of the aforementioned amendments.

Claim Objections

Claim 4 was objected to as being a substantial duplicate of claim 3 and claim 2 was objected to for a minor informality. As discussed above, claim 3 has been cancelled by this reply rendering the objection moot with respect to claim 4. Further, claim 2 has been amended to correct the informality indicated by the Examiner. Accordingly, withdrawal of the objections is respectfully requested.

Rejection under 35 U.S.C. § 102

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,904,953 ("Linsenbardt"). For the reasons set forth below, the rejection is respectfully traversed.

The following is an example of an embodiment of the present invention. The following example is not intended to limit the scope of the claims. Turning to the example, Figure 3 illustrates a tape winding step in a method for manufacturing a plurality of modules (*e.g.* smart cards). Figure 3 shows a reel (R) including a tape (T), where the tape (T) has been wound through the reel (R). Prior to the tape winding step, a plurality of chips (C) are affixed to the tape (T) using a liquid glue. Before the glue reaches a solid state, the tape (T) is wound through the reel (R) and subsequently heated in an oven (*e.g.* static or stream). Thus, in this embodiment, the entire reel may be placed in a reel (R) sized oven, eliminating the need for running the tape through a large inline oven. Following the heating step, the tape (T) may be unwound to connect the chips (C) to connecting elements. Further, in a resin depositing step, the chips (C) may be covered with resin,

and before the resin reaches a solid state, the tape (T) may be wound through the reel (R) a second time, and then subsequently heated a second time. Finally, the tape (T) may be cut, such that individual modules are formed, each including a glued connected chip protected by resin. (*see* Published Specification, paragraphs [0023]-[0031]).

Turning to the rejection, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (*See* MPEP § 2131). The Applicant respectfully asserts that Linsenbardt fails to disclose all the limitations of independent claim 1.

In particular, independent claim 1 recites, *inter alia*, “a method of manufacturing a tape to which a plurality of elements are affixed by means of a glue in a solid state...comprising a gluing step, in which *elements are glued to a basic tape* by means of a glue in a liquid state so as to obtain a glued tape...” The aforementioned limitations explicitly require *a plurality of elements affixed to a tape by liquid glue*. Linsenbardt is completely silent with respect to the aforementioned limitations as recited in independent claim 1.

In contrast to the claimed invention, Linsenbardt is directed to a method of applying an insulated coating to a flat metallic strip for winding into a magnetic coil. Linsenbardt is completely silent with respect to disclosing a plurality of elements. To that end, Linsenbardt also fails to disclose a single variation of glue, and thus, is completely silent with respect to disclosing a plurality of elements glued to a basic tape.

Moreover, the Examiner relies on a portion (*i.e.*, column 1, ll. 44-48) of Linsenbardt which stems from the background section to show the limitations disclosed in independent claim 1. However, the aforementioned portion cited by the Examiner is directed to manufacturing transformer coils where insulating paper is affixed in-between layers of conductive material by an adhesive before it is wound into a transformer. The mere four lines cited by the Examiner are completely *silent with respect to a plurality of elements glued to a basic tape*. In fact, from the brief description provided, Linsenbardt appears to only disclose encapsulating paper *inside* the metal strip and does not disclose *gluing any elements to the metal strip*.^{*} From the above, it is clear that both the cited portion and Linsenbardt's disclosed invention are completely silent with respect to gluing a plurality of elements to a tape to obtain a glued tape.

In view of the above, Linsenbardt fails to disclose all the limitations recited in independent claim 1. Accordingly, independent claim 1 is patentable over Linsenbardt. Thus, withdrawal of this rejection is respectfully requested.

Rejections under 35 U.S.C. § 103

Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Linsenbardt in view of U.S. Patent No. 5,403,395 ("McCullough"). Claim 3 has been cancelled by this reply. Accordingly, this rejection is now moot with respect to cancelled claim 3. To the extent that this rejection applies to pending dependent claims 2 and 4, the rejection is respectfully traversed.

^{*} "transformer coils are wound from a continuous metal strip with interleaved layers of insulation material" Linsenbardt, col. 1, ll. 40.

“To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” (*see* MPEP §2143). Further, all prior art relied upon by the Examiner in maintaining a 35 U.S.C. §103 rejection must be analogous art. Prior art is considered to be analogous, if the prior art is in the field of the applicant’s endeavor or is reasonably pertinent to the particular problem with which the invention is concerned. In *re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992) (*see* MPEP §2141.01(a)). The Applicant respectfully asserts that the cited references, whether considered separately or in combination, may not be used to maintain a rejection under 35 U.S.C. § 103.

In particular, Linsenbardt and McCullough do not qualify as analogous art under either of the aforementioned categories. First, with respect to Linsenbardt, Linsenbardt is not in the Applicant’s field of endeavor. Specifically, Linsenbardt is directed to a method for producing insulated metallic strips to use in the coils of power transformers (*see, e.g.,* Linsenbardt, Abstract), while the claimed invention is directed toward methods for manufacturing a tape including a plurality of elements (*e.g.,* smart cards).

Moreover, Linsenbardt is not relevant to the problem the invention is directed to solving. As discussed previously, one or more embodiments of the claimed invention are directed to mass-producing smart cards through heating a reel of tape to facilitate a more efficient use of space and time. (*see* Published Specification, pp. [0025]). In contrast, Linsenbardt is directed to replacing insulated paper with an insulated coating to reduce the thickness of a power transformer. (*see* Linsenbardt, col. 1, ll. 48-53). Thus, because Linsenbardt requires an insulated coating to form a

thinner conducting strip, the teaching of Linsenbardt is actually inapplicable to the technical field of the claimed invention. Said another way, one skilled in the art would not look to Linsenbardt to solve the problem the claimed invention solves. In view of the above, Linsenbardt is nonanalogous art and, thus, may not be used to maintain a rejection under 35 U.S.C. § 103.

Second, with respect to McCullough, McCullough is also not in the applicant's field of endeavor. McCullough is directed to an apparatus for applying topical substances uniformly to base products (*e.g.* dry cereals) (*see, e.g.*, McCullough, Abstract), while the claimed invention is directed toward methods for manufacturing a tape including a plurality of elements (*e.g.*, smart cards).

Moreover, McCullough is not relevant to the problem the invention is directed to solving. As discussed previously, one or more embodiments of the claimed invention are directed to mass-producing smart cards through heating a reel of tape to facilitate a more efficient use of space and time. (*see* Published Specification, pp. [0025]). In contrast, McCullough is directed to eliminating the inconsistent coating of base products by implementing a star-shaped reel in lieu of a cylindrical drum structure. (*see e.g.*, McCullough, FIG. 2 and 3). Thus, because the teaching of McCullough is directed to an entirely incongruent problem and solution, the teaching of McCullough is actually inapplicable to the technical field of the claimed invention. Said another way, one skilled in the art would not look to McCullough to solve the problem the claimed invention solves. In view of the above, McCullough is nonanalogous art and thus, may not be used to maintain a rejection under 35 U.S.C. § 103.

Finally, even assuming *arguendo* that both Linsenbardt and McCullough are considered analogous art, as discussed previously, Linsenbardt does not teach or suggest all the limitations of

independent claim 1. Moreover, McCullough does not teach that which Linsenbardt lacks. This is evidenced by the fact that McCullough is only relied upon to teach “a reel made of composition material,” (see Office Action mailed October 31, 2006 at p. 4). As shown, McCullough is completely silent with respect to a method of manufacturing a tape.

In view of the above, independent claim 1 is patentable over Linsenbardt and McCullough. Dependent claims 2 and 4 are patentable for at least the same reasons. Thus, withdrawal of this rejection is respectfully requested.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Linsenbardt in view of U.S. Patent No. 4,835,846 (“Juan”). For the reasons set forth below, the rejection is respectfully traversed.

Specifically, independent claim 5 includes at least the same patentable limitations as independent claim 1. As discussed previously, Linsenbardt does not teach or suggest all the limitations of independent claim 1 or alternatively, is nonanalogous art and thus, may not be relied upon to maintain a rejection under 35 U.S.C. § 103. Further, Juan does not teach that which Linsenbardt lacks. This is evidenced by the fact that Juan is only relied upon to teach “a semiconductor device, a cutting step, and an embedding step,” (see Office Action mailed October 31, 2006 at p. 5). Further, Juan is directed to a method for manufacturing electronic modules and is completely silent with respect to a method of manufacturing a tape. Specifically, Juan fails to teach or suggest semiconductor devices glued to a basic tape and an embedding step in which a module is embedded in a cardbody. (see e.g., Juan, Abstract). Accordingly, independent claim 5 is patentable over Linsenbardt and Juan. Thus, withdrawal of this rejection is respectfully requested.

New Claim

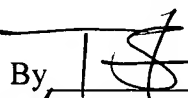
By way of this reply, new claim 6 has been added to specify that the reel may have a diameter bigger than 600 mm. Claim 6 corresponds to originally filed claim 3 excluding the reference characters. Claim 6 depends indirectly from independent claim 1 and, thus, is patentable over the cited prior art for at least the same reasons as independent claim 1. Accordingly, entry and allowance of new claim 6 is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09669/042001).

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Respectfully submitted,

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Attachment: (Applicant Initiated Interview Request Form)